

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Sir:

In accordance with 37 CFR 41.52, Appellant hereby requests rehearing of the 2 March 2009 decision of the Board of Patent Appeals and Interferences in Appeal No. 2008-3533.

That decision affirmed-in-part and reversed-in-part the final rejections of record.

Firstly, it is noted that the Board's decision is based in significant part on the KSR case handed down by the Supreme Court in 2007, after the prosecution of this application leading to this appeal.

In that regard, the examiner could not, and did not, apply the KSR case to the present application.

Furthermore, the Board's present findings of fact were not presented by the examiner in rejecting the claims, and have been proffered de novo by the Board, amounting to new rejections of the claims of record.

At page 2 (D.2), the Board recognizes the now normally long prosecution of the parent application and the present application, each now having received two decisions by four Boards of Appeal, with the present three-member Board being

different than the last three-member Board.

These various rejections by the same examiner, common to both applications, have mostly been in error, and have been repeatedly reversed time and time again by the various Boards.

Even the four Boards have proffered different rationales in reversing rejections, and presenting new rejections.

To be certain, the experienced examiner, and the more experienced members of the various Boards well have the ability to fabricate rejection after rejection without due regard to their ever continuing development of impermissible hindsight.

The more the examiner rejects the claims, and the Board reverses; the more determined are both the examiner and Board in re-rejecting the claims based on alternate theories of obviousness.

The facts of record are ample proof of the impermissible hindsight, now reflected in the latest decision by the present Board.

Now, the Board has the additional option of applying the new case law of KSR and its (A) through (G) exemplary "rationales" to support obviousness as found in MPEP 2141.

Yet, Applicant contends in this request for rehearing that the Board has presented erroneous "findings of fact" and has failed to properly apply the KSR case; and has fundamentally failed to provide any weight to the well known, and fundamental, patent law requirement to consider each claim "in the whole" as presented in MPEP 2141.02, for example.

The Board's decision to affirm certain rejections, and enter new rejections, is based in significant part on errors of fact; and the conspicuously apparent use of impermissible hindsight in using surgical precision, and Appellant's own specification indeed, to sustain or fabricate rejections of

all claims of record, notwithstanding the significant improvements in the insect swatter for which two previous Boards of Appeal have reversed previous erroneous rejections leading to the issuance of a U.S. Patent therefor.

The specification and Brief well disclose the substantial improvements in the insect swatter by incorporating the specially configured duplex lash for solving various problems, including improved striking range.

The improved combination may appear "simple" to the examiner, and to this Board, but KSR does not per se render obvious simple inventions, which this Board is de facto proffering under the guise of "predictable result."

To support such holding, this Board has distorted facts, misapplied the four references out of context, misapplied KSR, as well as failed to consider each claim in the whole.

To be certain, the four references being (re)applied by the Board have certain similarities, but are fundamentally different from each other nevertheless, proved by the issuance of four separate patents therefor by the USPTO.

Appellant's insect swatter is yet further different than the four references, but the Board has clearly failed to consider any of those differences, but instead has chosen to look at "apparent" similarities (e.g. Fact Finding (FF) 3) to the exclusion of those differences in sustaining certain rejections and entering new rejections.

Was not the examiner experienced enough to meet his duty to fully examine all claims under the applicable patent laws?

Note the voluminous rejections at paras. 2 and 3 of the final rejection in which the examiner first applied White and Watkins, and then the opposite combination of Watkins and White; with the Board at footnote 3 (FN.3) merely indicating that they "do not consider the order in which prior art is applied ... to be significant."

In shotgun effect, the examiner and the Board have loaded both barrels and fired at Appellants claims in an unwarranted attempt to reject claims having significant advantages over the very "prior art" being reapplied by the Board.

This, the Board now proffers with the conspicuous use of impermissible hindsight.

Since Appellant contends that the Board's decision is replete with errors and the rejections cannot be sustained, Appellant will now attempt to address some of those errors, with any one error being determinative to overcome the rejections.

Since the Board's decision is based on erroneous fact, then that entire decision is poisoned by the error(s)

Appellant requests a rehearing, *de novo*, of the entire record, but Appellant believes that since the Board has now made its decision of record, then it is unlikely that the Board will change that cast opinion, but will yet again do its best to find fault (error, see pg. 17 of Decision (D.17) re FF.12) in Appellants "assertion[s]", yet at the same time will sustain mere Board "assertions" made without due evidence or due support in logic or the law, including KSR.

FF.3 is clearly erroneous, and the Board's subsequent reliance thereon is therefore unwarranted, and erroneous.

The Board merely "asserts" that "The rubber bands of White thus appear identical, and there is little reason to suspect that they are not."

The Board further "asserts" that "Thus to a preponderance of the evidence, White discloses ... identical rubber bands"

What evidence is that?

What is the Board's definition of "identical?"

At page 14, the Board further asserts that "White intended the bands to be identical ..." Where is the evidence in White to support White's intention?

The failure of White to disclose or suggest identical bands was presented in the Brief at pp: 22, 24, 43, 48, 50, 51, and 84 for example.

In Figures 1 and 2 being now be used by the Board, the first band measures 41mm, the second band measures 37mm, and the third band measures 36mm; and clearly those bands are neither identical, nor "intended" to be identical, since their size is irrelevant to the "toy gun" of White (FF.22, D.16).

The Board's use of "p.1, ll. 21-22" for "old inner tire tubes" is too general, and lacks the specificity or "predictability" of KSR for any "identical" rubber bands, and is clear error, and mere unsupported assertion.

The Boards's mere use of p.1, ll. 87+ (and p. 2, ll. 16+), merely recognizes the alternate use of "one, two or three rubber bands of suitable strength," but lacks any analysis or teaching of why one, two, or three bands would be used; nor has any relevance to identical features.

What strength, and why?

In White, the bands are merely catapulted away, p.1, ll. 1+; and p.2, ll. 1+.

Strength, perhaps, means how far that discharge distance might or could or should be; but White is silent on such teaching, and clearly silent on any identical requirement.

"[F]ormed of old inner tire tubes," White expressly discloses, but how so formed?

The tube in toto?

Or, the tube cut?

Apparently the old tube is cut; and it would be impossible to cut three identical sections; and the Board cannot, and has not, shown otherwise.

Instead, the Board must necessarily assume evidence of identicality in White, because White lacks such teaching; and it is more likely than not, "preponderance" (FF.3) that the

bands in White are expressly not identical; and the Board's mere assertion lacks evidence or any logic.

Not only is FF.3 clearly erroneous, but that single finding is used initially and repeatedly by the Board in its decision, rendering that decision erroneous *per se*, and *in toto*.

Note further that the Board's findings of fact lack conformity, are disjointed, and are evidence in and of themselves of lack of cogency or careful analysis.

The findings shift from White to Watkins, back to White, back to Watkins, then to Robinson, back to White, back to Watkins, White, Kopp, and ending with Stone.

These findings are in part erroneous, and in part the very evidence of non-obviousness since the Board has selectively applied isolated teachings without regard to the whole of those teachings and without regard to the whole of each claim being evaluated.

The findings contain many, many examples of how the various references "fail to disclose" certain features, and those features are multiple features found in various combinations of various claims.

Those failures are later addressed hereinbelow in context of their misuse by the Board.

The Board's new FF.10 of the "slot 3" in White is irrelevant to Appellant's claims, and equally irrelevant to any of the other references being applied.

It is clear from the Board's assertion that "White fails to disclose said lash first loop is fixedly retained in said slot ..." that the Board equates one "slot" for any other "slot" no matter the structure of that slot, or the function of that slot, or, indeed its very use in the reference (White) being applied.

Note that the slot 3 in White is a "longitudinal slot ... [in which is] pivotally associated with the gun a member 4 which may be used as a sight when aiming the gun," p.1,

11.41+.

The Board later uses this isolated teaching of the slot 3 in White in an erroneous combination addressed hereinbelow.

FF.12 is erroneous, and taken out of context, for the Board's later erroneous use thereof in selective combination.

Col. 4, ll. 66-72, of Watkins applied by the Board more accurately states that "either of the guns shown in the appended drawings may be easily modified so as to shoot rubber bands rather than small projectiles merely by removing its pusher element-equipped rubber band from its slot and stretching a conventional rubber band from the front of the barrel to the upright pin."

This finding states that the Watkins gun could be transformed into the White-type gun, with both being configured to "shoot rubber bands," but the contrary is not so taught.

If the rubber band is attached in White in accordance with Watkins, then that rubber band is no longer "conventional" but is back to the "pusher element-equipped rubber band" specifically taught by Watkins.

So, any combination of White with Watkins (the order apparently not being relevant to this Board, FN. 3) would necessarily require that the one, two, or three bands of White being reconfigured under the express teachings of Watkins back to the pusher element form, which teaches away from Appellant's claims, not the contrary as the Board erroneously contends.

The Board's findings of fact are insidious for the isolated assertions taken out of context, and deceptive, for later use by the Board in the mere conclusions of obviousness, having lost relevance from that very isolated presentation of "fact."

The Board's attempt to present findings of fact out of context adds yet another mechanism to obfuscate, not clarify, the issues, which undermines the Board's "careful"

consideration of Appellant's traverse (D.13), and, indeed, the Board's own review of the record.

FF.13 is erroneous, per se.

Since the bands in White are "formed of old inner tire tubes," then it would appear impossible for those bands to be identical under any definition of that word, and therefore those old-tube bands could not have the spring rate found by the Board in FF.13.

To the contrary, since the bands in White appear to be hand made, those bands would be inherently different, not identical, and the combined spring rate could not possibly be "one-half the spring rate of either band," and the Board has not, and cannot show otherwise.

The Board well knows that its decisions must be based on evidence; and the Board's need to assume or speculate is evidence in and of itself of the very lack of evidence that the Board needs to support any rejection.

The Board is yet again reminded that the facts of the Decision itself are evidence of the very errors the Board now makes.

Why?

Because Appellant's invention appears to be remarkably simple in concept, but this was true for the parent for which a patent was issued over the same art of record.

The Board does not have that parent application/patent to use as prior art; and to the extent that parent was found patentable by two previous Boards, the present application should also be found patentable by the present Board, since the previous Board fully reversed the last set of rejections.

The Board in its careful review apparently has overlooked this fundamental fact, and any res judicata effect, of the many prior Board decisions, but attempts to sustain and fabricate new rejections in a belated attempt to reopen prosecution yet again, using the same references over and over again, now without regard to even the order in which

those references are being applied (FN.3).

Note in FF.13, the Board's simplistic reference to Hooke's Law, but without any attempt to apply that Law to the facts of White itself.

"Old inner tubes" is apparently all the Board needs to rush to reject Appellant's claims based on that well known Law.

But that rush to reject is obvious from erroneous FF.13, and yet again poisons all rejections based on that erroneous "fact."

FF.15 is taken out of context because the "knob a" of Robinson may open downwardly as the Board contends, but that knob "a" has no relevance to the other references being applied.

The Board has chosen to evaluate the knob fact of Robinson out of context for an example of downward-open, yet the cord C is custom designed to cooperate with the ball D in a manner unlike the other references.

FF.21 is an erroneous use of Appellant's own specification, and is yet again taken out of context.

The Board is required by law, including KSR, to present evidence, other than Appellant's own specification, to support rejections; and FF.21 is per se erroneous especially when used as any basis to reject Appellant's very claims being carefully evaluated by the Board.

FF.22 is per se evidence of the non-obviousness of Appellant's claims since the Board, itself, has expressly admitted that White discloses "a simple toy gun ... [in which] ... a rubber band is discharged ...," and a toy gun is non-analogous to the recited insect swatter, since the former is admittedly a toy, and the latter is a machine or mechanism constructed to perform work.

Furthermore, this fundamental teaching of White expressly found by the Board in FF.22 is express evidence that it would not be obvious to fundamentally change the gun

therein for retaining the rubber bands at the end thereof.

If that were done, as the Board later contends, the gun in White would be rendered inoperable for its intended use of discharging the rubber bands.

A mere toy, the Board later opines?

Nevertheless that toy would be rendered inoperable for its express use, not a hindsight-contrived use by the Board as a mere toy.

Note that FF.23 is the first finding where the Board has indeed found a reference of an "insect swatter," albeit a quite different insect swatter in Kopp.

This FF.23 is evidence that the Board itself has been unable to find that White, Watkins, and Robinson disclose insect swatters; when, to the contrary, all three references White, Watkins, and Robinson expressly state that they disclose toy guns, and toy guns different from each other.

This FF.23 is further evidence, by the Board itself, that those three references are non-analogous art; and furthermore, those three references teach away from any combination of the four references that would be relevant to Appellant's claims.

FF.26 is erroneous, and taken out of context.

P.1, ll. 76-79 of Kopp more accurately states that "[w]hile I have shown my device of a single form, it is obvious that many modifications and changes therein may be made as to size, shape and form of the parts, and the use of different materials, whether wood or metal"

However, that teaching is mere generality and fails to explain what those variations would be and why.

And, that teaching cannot fundamentally change the toy gun in Kopp, or it would be rendered inoperable for its specific intended purpose.

Note the special configuration of the toy gun in the figures of Kopp. The band 5 has a special or custom shape, and is a single strand with a knob 6 at its end.

Clearly, the Board has made FF.26 in anticipation of rejecting Appellant's claims based on the hindsight combination of naked elements out of context.

FF.27 and 28 are new findings, clearly being proffered by the Board to support yet another hindsight combination of disparate references for the planned rejection of each and every one of Appellant's claims, without any apparent regard to the exceptionally long and protracted history of prosecution.

In affect, the Board has chosen to disregard the issuance of the parent patent for the Board-recognized patentable novelty thereof; and now disregards the significant improvements in that previous insect swatter after testing has shown specific need therefor.

Now, the Board has merely asserted that Appellant's improvement invention is merely obvious without any regard to the whole of Appellant's claims, including the problems being solved; but instead relying on the general rationales of newly decided KSR, without regard to the specific requirements thereof, lacking in the present Board's decision.

Fundamental to the application of any case law, including KSR, is the prerequisite showing of similar facts, which this Board has failed to do in its latest rush to (re)reject the claims.

Beginning at page 10, the Board introduces KSR under the applicable principles of law, and continues through page 12.

But, that repetition of excerpts from the law still lacks factual nexus with Appellant's claims as further addressed hereinbelow.

The Board's assertion, D.13, that White discloses all features except for the retained lash is erroneous since fundamentally White teaches a toy gun differently configured to discharge the rubber bands.

The Board then asserts teachings from Watkins, with a mere conclusory statement of obviousness.

The Board asserts that "familiar elements" of White and Watkins are being combined and "does no more than yield the predictable result of converting a rubber band shooting gun into a rubber band whipping gun."

The Board additionally concludes, D.14, that "[t]his result is expressly suggested by Watkins and therefore would have been obvious"

These are mere conclusions and lack nexus with the requisite showing of facts under KSR, and are clearly erroneous.

The Board appears to be applying rationales A and B from KSR, see MPEP 2141, without regard to context or factual basis, and without due analysis and explanation.

Recall FN.3 wherein this Board indicates that it does not consider the order of applying references to be relevant.

This assertion would appear in itself to be clearly erroneous under any patent law, including KSR, and the Board's reference to Bush has not been explained in context.

So, for the rejection of claims 1 et seq under White and Watkins, which combination or order is the Board applying?

At page 13, it appears that notwithstanding FN.3, the Board is modifying the toy gun of White, i.e. the "rubber band shooting gun," into the "rubber band whipping gun" of Watkins.

Is this what the Board intended? The Board's contentions are at best confusing, and undermine the very rejections; and this critical and fundamental feature.

If, indeed, the Board contends that the shooting gun of White is being modified, interchanged, predictable, by fixing the otherwise free end at sight 4; there is clearly no evidentiary or legal support therefor.

How would it be even possible to fix the free end when

no such structure, including the longitudinal slot 3 is available for that configuration?

And, such a modification would clearly render the toy gun of White inoperable for its intended purpose, which is to expressly discharge the rubber bands "to a considerable distance," p.1, ll.1+ and p.2, ll. 1+.

What "fun" to the user of the White toy gun would be that toy gun which could not discharge or fire the rubber bands?

To this Board, that fundamental purpose of White is irrelevant (in hindsight) because this Board must so conclude in order to support the rejection.

At D.16, the Board sidesteps this critical issue by making the bald assertion that "Firstly, the intended purpose of White is to provide a toy ... [and] There is no evidence to support the proposition that White would cease to be operable as a toy if an end of the band were fixed to the distal end of the gun."

Remarkable, this bald contention of the Board is.

No evidence, the Board baldly asserts?

Where is the Board's legal basis for these bald assertions?

Where does KSR or any other case cited by the Board permit such bald assertions.

No, the Board itself has failed to consider the very evidence of the references themselves in the blatant attempt to support insupportable rejections.

It is not likely that this Board will reverse this erroneous opinion, next leading to further appeal to the Federal Circuit.

On such a fundamental, and simple issue, this Board has chosen the erroneous conclusion.

A toy, the Board baldly opines?

But that "toy" is nevertheless a combination of individual elements, which are combined in a specific manner

for a specific function and specific purpose (intended use).

The Board has overlooked that structure, function, and purpose to fabricate the rejection without regard to facts, because the Board has no other avenue to reject the claims.

Note the inconsistency of this Board in overlooking the claim preamble, express structure, function, purpose in the references, and then failing to afford due weight to Appellant's structure, function, and purpose without regard to the preamble, D.16.

The Board is duty bound to consider at least structure, and function, and purpose especially when those features "breathe life and meaning into the claim," D.16.

But no, the Board has chosen to disregard such structure, function, and purpose by erroneously recharacterizing the White toy gun as a mere toy, which could be reconfigured any which way, D.16, whether or not the band end is fixed or free.

Notwithstanding the Board's unsupported conclusions, White indeed presents sufficient evidence of its structure, function, purpose, since the Patent Office itself issued that very patent for the novel features thereof.

P.1, l. 3, of White expressly states the fundamental purpose of discharging an elastic band.

P.2, ll. 1+, expressly state that this fundamental purpose is to discharge the bands "to a considerable distance."

In this regard, the Board's mere assertion at D.16 that "None of these objectives necessarily requires that the entire rubber band be completely discharged from the gun ..." is clearly erroneous since the plain English language description of White so states that the fundamental purpose of the toy gun in White is to discharge that band "to a considerable distance."

A considerable distance would be as far as possible to give maximum joy to the user, which user is using the gun in

White as a "toy," as the Board well recognizes.

The user, i.e. child, would find little benefit in modifying the toy gun so that the band were not fired away, would he?

Why not remove the band altogether and use the toy gun as a baseball bat, perhaps?

Where does the illogic of the Board end?

Toy?

Back to D.13, the Board further contends interchanging of parts, in apparent reference to KSR rationale B on simple substitution of parts.

But no, the Board is not properly applying the factual basis of KSR for simple substitution; since not only must the disparate configurations of the different bands in White and Watkins be interchanged or substituted, but the free band in White must instead be fixed therein.

That requires at least two fundamental changes, which is clear evidence against any "simple substitution;" and the Board has not shown otherwise in its rush to reject.

And, what "predictable result" does the Board proffer at D.13?

In White, the free end must instead be fixed, rendering inoperable that toy gun for its express purpose.

In Watkins, the fixed end is found, and the special band/pouch would need to be changed, but that would render inoperable the Watkins toy gun for shooting the projectiles.

Which interchanging does the Board proffer?

Not only has the Board failed to specify the requisite modifications of White or Watkins, but the Board has apparently failed to maintain that selection throughout the decision, rendering further confusing what the Board intended, and whether an objective and cogent analysis has been made and presented.

Appellant need not speculate as to the Board's decision, nor should the record be so confusing.

Clearly, the fundamental change from a fixed band which stays attached to the gun in Watkins to a free band which is discharged in White is not the type of "predictable result" contemplated by KSR, or vice versa.

Predictable result in White would apparently be any form of the bands which could be discharged away, which includes one, two, or three bands expressly (predictably) taught by White itself at p.2, ll. 87+ and p.2, ll. 16+; and perhaps more than three bands, or single or multiple bands, etc.

Where is any evidentiary support in White that instead of keeping the free end free, that free end could or would with any predictability be fixed to prevent discharge?

The Board asserts that Watkins "expressly sugges[ts]" the predictable-result conversion or interchange; but there is no evidentiary or logic or legal support for this mere assertion.

FF.4 & 11 applied by the Board at D.13 expressly require the Watkins band to be fixed, not the disparate bands in White.

The Board further asserts at D.13 that Watkins teaches the conversion "between operational modes" (FF.12), but what conversion is that in particular, and how is that relevant to modifying either Watkins or White?

At col.4, ll. 63, Watkins teaches that its invention could be applied to other toys, not vice versa as the Board appears to baldly assert.

Let's repeat this express teaching: Watkins states that its own toy gun could be converted from a projectile shooter to a band shooter.

Watkins does not teach the corollary that any toy gun, like White, could be converted from its original form into the Watkins forms.

This is a major leap of assertion by the Board in finding an incidental teaching in a disparate reference and

applying it clearly out of context without regard to the KSR requirements.

Does the order of references (FN.3) matter in this context? Of course it would.

The Board has at its disposal over 7,000,000 patents; and clearly selecting patents and applying those patents requires careful and thorough analysis, and a suitable order of combination and corresponding legal rationale.

Why has the Board not first started with the incidental reference Stone, later applied, and worked backwards into White and Watkins?

Does the order of applying references have meaning?

The U.S. Space Shuttle is credited with being the most complex machine on Earth, and, of course, it is nothing but a combination of conventional components, every one of which would have "predictable" functions, and, according to this Board's "logic" then no patent could ever be possible for the shuttle because all combinations of its conventional parts could be combined for their predictable results.

Absurd, such a contention would be, of course; but equally absurd is the Board's attempt to wholly convert or reconstruct the "rubber band shooting gun" of White into "a rubber band whipping gun" based on Watkins, when Watkins clearly has no teaching on any "whipping" at all.

The Board has been trapped by its superficial review of the references.

On the one hand, the Board recognizes that the Watkins toy gun is configured to shoot projectiles.

But on the other hand, the Board has overlooked this fundamental fact, but instead has recharacterized the Watkins toy gun as a "whipping gun" when no evidentiary or logical support exists therefor.

What does Watkins in fact teach?

Watkins teaches that instead of fixing the special pusher element in its toy gun (not White's), then the

interchange or (mere) substitution of a "conventional rubber band" could be used to "shoot" such rubber band, yet again in its own toy gun.

In other words, Watkins expressly teaches that its toy gun could be modified into the form of the toy gun of White to shoot or discharge the rubber bands.

But, the contrary is neither true, nor supported by any evidence in these references, nor supported by KSR, and the Board has not shown otherwise.

The Board is quite loose or inaccurate in its findings of fact, especially in this critical feature which well distinguishes Appellant's claims over all the art of record.

Both White and Watkins teach special structure, function, purpose for their respective toy guns, with the former expressly requiring that the gun be configured to discharge or shoot the one, two, or three interconnected rubber bands, whereas the latter teaches a special fixed band to propel the disparate projectile, or a conventional band for the mere shooting use thereof.

The Board has failed to present any evidence that the one, two, or three bands of White would instead be substituted for the special pusher element band in Watkins since even that alternate combination would lack proper structure to shoot the separate projectile.

Either combination of White and Watkins would render the combinations inoperable for their intended purpose; and the Board's mere recharacterizing of that purpose as a "toy" (D.16) is without evidentiary or legal support, nor even any logic.

That assertion by the Board is conspicuous for the lack of due consideration of Appellant's claims in the whole; and the overly simplistic use of naked elements from the applied references without regard to their context.

No patent application could ever result in a patent if the Board is allowed to surgically select naked elements

without regard to context, and then distort the express teachings of the very references being applied, as this Board has done.

At D.14, the Board continues with unsubstantiated and erroneous conclusions.

The Board first states that the bands of White are cut from tire tubes and then erroneously concludes that they would be "identical in all aspects except potentially height, citing erroneous FF.3.

What then is the Board's definition of "identical" if not "identical?"

The Board expressly admits that the cut-tube bands of White cannot possibly be identical, but nevertheless continues the rejection.

This is blatant error; since if the Board will not afford any weight to plain English terms, what possible weight will this Board ever afford?

"Broadest reasonable interpretation" the Board simply opines. How does this MPEP provision permit the redefinition of identical as being maybe or approximately identical, but not really identical?

What is identical?

Nearly identical is reasonable enough to this Board?

Appellant only has the English language to use in drafting claims, and the MPEP also requires the Board to afford standard definitions to terms, notwithstanding reasonably broad interpretations.

Identical is an absolute term, and is so used in the context of the recite identical rubber bands produced by conventional processes, which conventional processes do not include hand cutting from old inner tubes.

To be certain, this interpretation by the Board is unreasonable and excessively strained in the guise of "reasonableness" when clear no such reasonableness can be found in failing to afford plain meaning to the plain term.

Appellant's claims do not recite "nearly identical" or "generally identical," but "identical" without qualification; and the reason therefore is expressly found in the specification to overcome the stated problem of custom made bands, of which the cut-tire bands of White would be one example, as well as the special projectile-shooting band of Watkins.

The Board has previously chosen to ignore these important features, previously presented in both the written specification and the main Brief; this, the Board has done under its "careful" consideration (D.13).

Can now, or will now this same Board objectively evaluate this reargument of a previous argument, now being made to traverse erroneous conclusions of the Board?

The Board goes so far as to substitute its "intention" for that of the White reference itself.

The Board baldly opines that "From Figure 1, it can be observed that White intended the bands to be identical in that [height] respect as well."

Where does Figure 1 of White present any such evidence of "intention?"

This assertion is legally absurd for blatant want of evidence, and is belied by the express teachings of White, itself.

"Old inner tire tubes" White expressly teaches at p.1, 11. 19+.

The Board's FF.3 has been traversed above, and Appellant additionally traverses this additional assertion of the Board over what White "intention."

And, the Board itself at D.14 asserts that the bands of White are "cut from tire tubes," which, of course, cannot possibly create "identical" rubber bands, intended or not.

To the contrary, identical bands are irrelevant in White because the Board, itself, well recognizes that the gun in White is nothing more than a mere "toy," D.16, which can

use one or two or three bands, with the configuration of each band being entirely (intentionally?) irrelevant to the purpose of the toy to shoot the bands, or not as the Board's erroneously contends in the alternate.

Notwithstanding the "same stipple" FF.3, which, of course, would result from using the same old tire tube, any cutting of those old tire tubes could not possibly result in "identical" bands in all respects, including height as well.

The Board's findings are clearly erroneous, and all conclusions made therefrom are equally erroneous and undermine all rejections.

The Board is suggested to simply measure the bands shown in Figures 1 and 2 of White, and that measurement will clearly show that those bands are clearly not "identical" in any definition of that term; especially in contradistinction with Appellant's identical bands which are so identical by modern commercial manufacture, and are not simply cut from old tires.

This erroneous assertion by the Board is further evidence of the danger in the Board's findings of naked elements divorced from context and reality, and combined in hindsight under the academic and highly abstract interpretations under the patent law.

If the Board intends to apply modern patent law in the evaluation of Appellant's claims, then the Board must also apply that same law to the very references being applied.

Appellant's claims recite specific structure, in specific cooperation, with specific function, for specific purpose to solve specific and stated problems, and have no counterparts in the applied references.

Note, quite conspicuously, that the Board is applying references not for teachings specific to Appellant's stated problems and resulting solutions, but for disparate teachings, which of course, the law, including KSR allow.

The danger in that alternate combination is that that

combination still must be effected based on suitable evidence to combine corresponding features under any one or more of the permissible legal rationales or motivations, now specified in the KSR decision.

The Board's rejections fail to meet those stringent standards, and even a cursory review of the necessary assumptions and assertions and distortions of fact will clearly show that the rejections are unsubstantiated and unwarranted.

Citing FF.19, the Board at D.14 further contends that White "leaves it up to the practitioner to determine the characteristics making the bands suitable."

And, where is that expressly taught in White?

The Board's reference to p.2, 1.18 & p.1, 1.88, does not support such a broad contention; nor do these assertions by the Board have any relevance to the "identical" feature.

At p.2, 1.18, White discloses suitable length, which is not identical length, but would more likely than not be that suitable length required to simply fit the toy gun.

One band would be suitably long, two bands would be suitably shorter, and three bands would be shorter still.

Of what relevance is this "suitability" to identical bands?

At p. 1, 1.88, White discloses one, two, or three bands of suitable strength. And, what strength is that, and of what relevance to strength is identical bands?

At p. 2, 11. 1+, White expressly teaches discharging the bands "to a considerable distance."

So, shouldn't suitable strength be "reasonably" interpreted to be that strength which will maximize the shooting distance?

But, what strength would be required of one versus two versus three bands in White? That is subject to speculation, and neither White nor the Board has explained that, nor has the Board shown any relevance between strength and

identicality.

At D.15, the Board further asserts that "One of ordinary skill in the art would recognize that the force transferred to the projectile is affected by the dimensional changes of the band ... selecting specific dimensional characteristics of the band is a matter of design choice which does no more than yield the predictable result of altering force output of the band"

What does all of this mean in any context?

Does the Board understand this very assertion?

What force, what strength, what design choice?

Indeed what choice at all?

"Force transferred to the projectile" the Board asserts.

And, what "force" is that? Large force, small force, medium force?

In White, the bands should be configured to shoot those very bands to maximize the "considerable distance." Is not that true under the teachings of White?

In Watkins, the band should also be configured to maximize the shooting distance, i.e. "the shorter the length ... the greater the impetus [force] given to the projectiles shot by the gun," p.3, ll. 33+.

And, would not the band shooting alternate in Watkins at p.4, ll. 64+, also require band configuration to maximize the shooting distance?

What then is the relevance of these express teachings of White and Watkins for band configuration and design choice and predictable results being asserted by the Board?

Would not that very "design choice" asserted by the Board require the strongest configuration to maximize shooting distance as expressly taught by White and Watkins?

Of course, yes.

But, that is quite the opposite to Appellant's claimed invention.

The specification, eg para. 7, clearly states that strong bands are not preferred.

Instead, the series combination of individual bands is preferred and claimed because that series has less, not more, strength and force for the advantages specified in the specification (whole analysis).

Note FF.13 and Hooke's Law cited by the Board.

What does such law teach to one skilled in the art of strength and force and design choice and predictable results?

Contrary to the Board's mere assertion, the strength and force in the three bands of White are weak or low and would decrease the shooting range when the bands were shot.

Why, because the proper application of Hooke's Law so holds that the resilience increases and the force decreases.

The same would apply if the Board were to fix the end of the three bands to the gun: force and strength are decreased over Watkins.

In Watkins, a single, fat band is disclosed which should be as short as possible and as strong as possible to maximize shooting force and strength, which the Board must inherently recognize from its own statement at D.15.

So, the Board's assertion to fix the three bands in White is unsupported by Watkins, unsupported by any evidence, and against its own stated "design choice" which would require stronger, not weaker, bands if the bands in White were to be fixed.

This error by the Board is further evidence of the superficial, not careful, analysis proffered by the Board in selecting naked elements without regard to context or even technical merit, and "simply" combining them in hindsight, because, of course, that is the "simple" thing to do.

However, MPEP ch. 2100, and the KSR case are not so "simple" to apply, and mandate thorough analysis of each reference and each claim in the whole, which the Board has clearly not done in its continued rush to re-reject

Appellant's claims, now at appeal level, instead of at the examiner level.

This, the Board further opines in hindsight at D.14 to support "identical" bands, when no such suggestion is even remotely possible in White being applied.

Indeed, the Board then attempts, D.14, to use Appellant's own specification, at FF.21, to support an insupportable contention and insupportable rejection.

Under what case law, including KSR, does the Board find any legal basis to use Appellant's own written specification of Appellant's own invention being recited in Appellant's own claims as a basis to reject those very claims being "carefully considered?"

This is further clear error by the Board.

What does Appellant's para. 55 disclose?

Paras. 7-9 of the specification present special problems for the recited insect swatter, which are neither found in the references being applied, nor relevant thereto, especially since the Board characterizes the toy guns thereof, as nothing more than toys, for which such problems would apparently be irrelevant.

These problems include striking range, swatting energy, material degradation, and, quite significantly, cost attributable to custom made bands having the requisite combination of features for maximizing the insect swatting ability of the swatter.

Has the Board afforded any weight to these problems?

Has the Board considered Appellant's claims in the whole?

Apparently not, since at D.14 the Board expressly uses the unwarranted and erroneous FF.19 as a basis to further contend that "The use of standard, commonly available rubber bands which are identical in a matter of design choice which does no more than yield predictable result of facilitating construction of the device."

Yet again, the Board attempts to baldly assert "predictable results" without citing any of the applicable KSR rationales A-G, and therefore without making the prerequisite showing of similar facts; and added to that assertion the Board now compounds the errors by merely asserting "design choice."

"Design choice," the Board baldly opines based on FF.19, Appellant's own teaching. This is clearly erroneous.

"Design choice," the Board baldly opines after first combining two disparate references having different configurations of bands, and then merely asserting that it would have then been mere design choice to further modify the interchanged bands to achieve identical configurations to "facilitate construction of the device."

This, too, is clearly erroneous and a bootstrapping of different legal principles in a manner for which they were never intended; and without even any reference to specific case law, or similar facts therein.

KSR rational B, for example, requires a "simple substitution of one known element for another."

Has the Board met this provision?

Has the Board first attempted to substitute the three bands of White for the single band of Watkins?

And now the Board attempts to re-substitute the three cut-tire bands of White for commonly available bands?

Where then will the Board's misuse of case law end?

"Predictable result" the Board opines?

What is that predictable result?

The Board, itself, simply states that that result is merely "facilitating construction of the device."

Where is the teaching of this assertion, and what legal support is found in KSR, for example?

The Board compounds the errors, with error upon error, which in and of itself is further evidence of nonobviousness, not obviousness.

The Board has substantial legal experience; and has KSR so changed fundamental principles of common patent law that the Board will uphold these clearly erroneous and unsupported assertions and rejections?

Will the Board specify that its decision cannot be used as legal precedent to avoid further review of these challenged legal principles?

Of course, "standard, commonly available rubber bands" can be found at any stationery store.

But such bands are naked elements, and in and of themselves have no relevance in rejecting any patent claims, including those of Appellant.

Perhaps common rubber bands could be used in White; but, recall, that the express purpose of those bands is to shoot the bands themselves to a considerable distance.

Identical bands matter nothing for that intended use or purpose; and as a toy gun, the child user would find no difference in cut-tire bands or common bands.

But, the Board is not simply modifying the toy gun in White, or substituting common bands therein.

Instead, the Board appears to be first fixing the free band in White; and then substituting common bands for the cut-tire bands.

Or, is the Board first substituting the fixed special band & pouch of Watkins with the three cut-tire bands of White; and then substituting common bands for the so substituted three bands?

Does not the order of application of White and Watkins matter, notwithstanding FN.3?

The Board should clarify the basis of rejection and explain either the combination of White and Watkins, or the combination of Watkins and White, or both; and the requisite rationales.

Instead of clarifying issues and presenting a cogent basis to reject the claims, the Board has obfuscated the

issues and rejections, making ever more difficult Appellant's traverse of the rejections, requiring unwarranted speculation as to the Board's meanings, evidentiary bases, and application of legal precedent.

Accordingly, for these exemplary reasons the Board's affirmance of the rejection of claims 1, 3, 5, 10-12 and 17-21 should be withdrawn.

Appellant traverses the Board's affirmance of the rejection of claims 14-16 and 22, and contends that all the features therein are not disclosed in White except for the specific dimensions as the Board contends at D.14.

The Board's affirmance is based on the unexplained "modification of White with the teachings of Watkins to include a keyhole slot."

Now, the Board is modifying White based on Watkins, and not vice versa.

Furthermore, the Board repeats its use of the keyhole slot of Watkins into White without regard to the different structure thereof.

Fundamental in White is the special form of the longitudinal slot 3 having no counterpart nor predictable results from Watkins.

The slot in Watkins is specially configured to extend transversely through the end of the gun, and not longitudinally therethrough.

Accordingly, the Board has no evidence to first reconfigure the longitudinal slot in White into a transverse slot from Watkins, and then fix the three-bands thereto.

Which rational of KSR applies to this further modification of White?

The Board has previously applied interchangeable parts and mere substitution for the bands themselves, but now must also interchange the slots and modify those slots for function not previously intended in the main reference, be it White, or Watkins.

These additional structural changes by the Board compound the requisite changes and are further evidence against simple interchangeable parts or mere substitution of parts, not to mention the further compounding of error addressed above by further contending that the form of the duplex band is then mere "design choice."

At D.15, the Board fails to address the specific features of these claims, and uses hindsight combination and bootstrapping to support the rejections without evidentiary or legal basis.

The Board applies FF.19 for suitable length and strength, but those features are irrelevant as presented above.

The Board applies FF.20 for force, but that feature is irrelevant as also presented above.

Indeed, the Board now recognizes that the force is specific to shooting the projectile, yet the Board's own modification has already eliminated that very projectile-shooting capability.

Remarkable, is the Board's inconsistency in applying the disparate references.

Remarkable also for the learned Board are the compounding of errors, and the failure to maintain a constant and cogent line of rejection; and instead relying on features taken out of context, without regard to the specific features of each claim.

In the main Brief, Appellant argued each and every claim for the different combinations of features therein, and the Board acknowledged this at D.13.

However, the Board has clearly failed to address those individual claims, either in the rejections traversed above, or in the further rejections of claims 14 et seq.

Instead, the Board yet again improperly relies on the mere assertion of "design choice" at D.15 for predictable result of "altering the force output ... [which] would have

been obvious," without regard to the specificity requirements of KSR, and without any regard that such an assertion of "design choice" must first follow substantial modifications of either White, or Watkins, prior to then applying such design choice.

This bootstrapping by the Board is quite apparent.

The Board has failed to show that such assertion of design choice can be used after major changes are first required in combining references, as the case here; whereas design choice might properly be applied where single choice changes might be warranted.

Nevertheless, in evaluating the claims in the whole, the Board is duty bound to consider the claims in the whole, and that analysis mandates review of the specification for the special problems being solved, and the claimed solutions therefor.

This, the Board has failed to due under the improper expedient of design choice, which has no applicability under the present facts.

The specific features of claims 14-16 and 22 have been previously presented in the main Brief and the specification, and find no relevance in the references being applied.

In White, the three bands are merely shot away.

In Watkins, the special band/pouch is configured to shoot projectiles.

Design choice under these facts might better be "length and strength" of the three bands in White, if those were the only changes between White and Appellant's claims, which they are not.

Design choice under Watkins, might be the strength of the single, not multiple, band for shooting a projectile, if those were the only changes between Watkins and Appellant's claims, which they are not.

The Board should be mindful, that the Board itself is making fundamental modifications of White from Watkins, or

vice versa, and after having made those fundamental modifications the same Board then affirms rejections of dependent claims reciting in specificity significant features without regard to the whole analysis, and this is clearly apparent and clearly erroneous.

Note that the Board has been able to apply only generally related toy guns, of which the art has many; and then for extracting naked elements thereof, with the hindsight conclusion of obvious combination.

This same Board, lacking similar evidence of naked features pertaining to the "specific dimensions" D.14, then conspicuously applies the examination expedient of "design choice" and mere "predictability," when no such legal support is available, not even under the facts of KSR.

Why then has the Board now intentionally chosen to disregard not only the fundamental differences of Appellant's claims over the disparate art of record, but even disregard the dependent claims with the special features solving special problems having no counterpart in the references?

KSR contains many rationales based on predictable results, and this Board is now attempting to use that case without regard to a fair evaluation thereof, or the legal requirement of similar facts.

As indicated above, MPEP 2143 presents many examples of facts for which the different KSR rationales might be properly applied, yet the Board has failed ab initio to match any such facts, but has instead chosen the expedient of lack-of-evidence to reject the claims under the guise of only the simple similarities of the references, without regard to their fundamental differences.

The Board's affirmance of the rejection of claims 14-16 and 22 therefore lacks suitable evidence, legal analysis, and appropriate legal motivation or rationale specific to the specific combinations of features recited in these claims.

Appellant traverses the Board's affirmance of the

rejection of claim 9 as found at D.15.

The Board now combines three disparate references to further include Robinson yet again based on "simply substituting ..." and "design choice."

As indicated above, there is no simple substitution here or design choice because the Board must first make substantial modifications of White to incorporate Watkins.

In White, the slot 3 is longitudinal.

In Watkins, the transverse slot opens upwardly, but has no relevance to the longitudinal slot in White.

And in Robinson, the knob "a" is further differently configured than either slot in White and Watkins.

Notwithstanding the Board's mere assertions, the longitudinal slot in White is not being "simply substituted" by the slot in Watkins, and further modified by the knob "a" in Robinson; nor is there any predictable result in view of the different structural and functional differences between the three disparate references, which this Board refuses to recognize in the rush to reject.

Should the Board sustain this rejection, Appellant requests that the Board better explain what a "simple substitution" entails under these facts, or applicable case law; and further explain the "predictable results" relevant to the proposed modification in otherwise fundamentally different references.

It appears that this Board has prejudged this application, notwithstanding the protracted history, and Appellant would appreciate a fair and objective evaluation of this rehearing request since this traverse is, indeed, being made in good faith based on what appear to be clear errors, especially when viewed in combination.

Appellant traverses the Board's affirmance at D.16 of White, Watkins, and Robinson being analogous art.

Appellant notes the Board's opinion of "intended use," but Appellant's claims are not written in functional or

intended use form in the preambles, but instead expressly recite an apparatus in the stated form of an "insect swatter."

Of course, an insect swatter is clearly not a toy gun.

The claims in White expressly recite a "toy gun."

The claims in Watkins expressly recite a "toy gun."

And, Robinson expressly recites a "ball toy gun."

These very references being applied by the Board are evidence in and of themselves that the Patent Office itself recognizes the claim expression of "toy gun," whereas Appellant's claims to the contrary expressly recite, not a toy gun, but an insect swatter, as a functioning machine or apparatus.

In the Kropa case cited by Appellant, and found in MPEP 2111.02, the claim at issue recited "An abrasive article" which was found by the CCPA to be "essential to point out the invention defined by the claims."

Similarly, Appellant's claims expressly recite an "insect swatter" which is similarly essential to point out the invention, and it is only by this phrase that it can be known that the recited device (no recitation of gun) is an insect swatter configured for that function and purpose as opposed to toy guns.

It would appear that the facts are similar between Kropa and Appellant's claims, and therefore the conclusion of nonanalogous art should be the same.

The Board's holding is a mere conclusion lacking any evidence or analysis, which is evidence and analysis are hereby requested.

Perhaps the Board might suggest preamble language to remove the applied references as analogous art; and Appellant would certainly entertain such further amendment to avoid these protracted prosecutions.

It is noted that neither the examiner, nor the various Boards have offered suggestions to this Appellant to further

amend the claims for better distinguishing over the art.

To be certain, the PTO has already approved the patent on the parent application; and the present application presents a significant improvement lacking any relevance in the various references being applied in naked hindsight.

As for the Board's mere conclusion that the three references are from the same field of endeavor and pertinent to the "problem of killing insects..." this assertion is against the very references themselves.

Neither White, nor Watkins, nor Watkins have fields of endeavor for insect swatters, and, to the contrary, are specifically related to toy guns.

The Board itself is on record that a toy gun is nothing but a toy; and as a toy it is not seen how any person skilled in the art would have found the field of endeavor of toys in any way relevant to the field of insect swatters.

At least the Board could offer some evidence in the three references of a specific teachings for use as an insect swatter; but the Board has not, but instead has chosen to rely on mere conclusion.

It is well understood that the Board as an appeal tribunal is charged with reviewing the wrapper to determine whether or not the examiner has met the applicable legal standards; and that appellate review requires suitable findings of fact, as the Board has attempted to do, but with errors, and that review requires legal support under the Statutes, and case law, like KSR.

And, the application of case law first requires the requisite showing of similar facts, which this Board has not (yet) provided, rendering the rejections unsubstantiated.

At D.10, the Board recognizes the burden of proof on the examiner; who has failed to meet that burden.

And now, the Board itself is subject to the same burden of proof for the new arguments and rejections being made de novo, especially based on the KSR case not present under the

final rejection or under the main Brief.

The errors in the Board's failure to suitably address the inoperability of the combined references at D.16 have been addressed above.

In *In re Gordon*, Brief 19, the Federal Circuit found that even the upside down use of a reference device was not obvious because in being upside down the device would have been rendered inoperable, which is evidence of nonobviousness.

The present Board recharacterizes White as only a toy, and expressly disregards its structure, function, and purpose for shooting the three bands.

This is clear error.

The Patent Office granted to the inventor in White a U.S. Patent for not merely a "toy" as this Board proffers, but a very special toy gun specifically configured for shooting the three-bands to a considerable distance.

That structure, that function, and that purpose would be wholly supplanted by the present Board under its hindsight modification to fix the band end to intentionally prevent shooting of the bands.

That modification clearly, and without any reasonable difference of opinion, has clearly modified/altered the fundamental nature of the toy gun as a shooting device for the band.

It is equally apparent that this Board has now decided *de novo* that this Board can alter the toy gun of White based on the teachings of Appellant's very own specification and claims to affix the band in White, and thereby create a new type of "toy gun" in which the three-bands remain attached.

This Board has jumped to this unwarranted conclusion, for to be certain, none of the applied references so teach or suggest; and the learned Board has clearly chosen to distort facts and the law to affirm rejections lacking suitable evidentiary basis.

Compounding these many errors being proffered by the Board under "careful consideration," the Board at D.16 blatantly asserts that "None of these objectives necessarily requires that the entire rubber band be completely discharged from the gun to achieve the overall objective of White."

And, what is that overall objective of White? A simple toy gun?

Tell that to the six year old child who first had a toy gun that could shoot the three bands; and then have his father modify that toy gun so that the three bands were no longer shot to the considerable distance expressly stated.

Would that child be happy with the "overall objective" of his new toy?

Clearly not.

This example is proffered for emphasis, because White expressly teaches the special structure, function, and purpose to shoot the three bands as far as possible, and it is only this leaned Board, in conspicuous hindsight, that merely asserts without any factual or logical basis that the bands could be indeed fixed, without any regard, without due regard to the specific written patent specification made under the stringent patent statutes, which expressly teaches to the contrary.

At D.17, the Board addresses the corresponding combination of Watkins and White (does this order of references matter under FN.3?).

The Board, itself, simply asserts without evidentiary or legal basis that Appellant's "assertion is in error since such a modification is explicitly suggested in Watkins (Fact 12)."

The Board's error in FF.12 has been presented above.

The Board's characterization of col. 4, ll. 66-72 is incorrect, and yet again taken out of context.

Col. 4, ll. 66-72, applied by the Board more accurately states that "either of the guns shown in the appended

drawings may be easily modified so as to shoot rubber bands rather than small projectiles merely by removing its pusher element-equipped rubber band from its slot and stretching a conventional rubber band from the front of the barrel to the upright pin."

What does this clear language teach or suggest?

Clearly not the Board's assertion in FF.12; and the Board's bald contention of Appellant "error" is without any support.

What does Watkins actually teach?

Two things.

First, and foremost, is the special configuration of the band and pouch to shoot projectiles.

And, of course, that configuration is not relevant to Appellant's claims in which the band is not configured to shoot projectiles, but, to the contrary, to not shoot any projectile, but instead whip the distal end of the lash.

Alternatively, Watkins teaches the modification of the toy gun by removing that special pusher band and stretching a conventional rubber band to shoot that band, in a manner apparently similar to White.

But, yet again, shooting away of rubber bands is not relevant to Appellant's claims of a whipping insect swatter.

The intended purposes in Watkins are therefore two: shoot small projectiles, or instead shoot away a different rubber band.

If the band/pouch is substituted by the three bands of White, there can be no doubt that the first intended use to shoot projectiles has been lost, and therefor that modification of the toy gun is quite inoperable for that expressed (intended) purpose.

If the band/pouch is also removed and substituted with the attached three bands, then the second intended use of the toy gun in Watkins is also lost because the three substituted and attached bands cannot be shot away as also expressly

taught by Watkins.

It is only this Board that has failed to afford due weight to these express teachings.

And, it is this Board who has asserted without any evidentiary basis that "This [Appellant's] assertion is in error ..." when this is clearly not the case.

Accordingly, of what value is the case law on inoperable art, if this Board refuses to afford any weight thereto, by merely recharacterizing the intended operability of a reference to meets its prejudged objective to reject the claims, all the claims?

Should the Board affirm this provision, Appellant requests the citation of applicable case law in support thereof, and the requisite legal analysis of comparable facts.

Appellant traverses the new ground of rejection of claims 1, 3, 5, 6, and 22 under Section 103(a) over Kopp and White as presented at D.18.

It is clearly not a "simple substitution of the White lash for that of Kopp [nor] does no more than yield the predictable result of sizing the lash appropriately for the gun"

Kopp requires a special single band 5 with a pin/staple fixed end 4 and an opposite knob 6 mounted in fixed piece 7 having recess 8.

The three bands in White have double strands due to their construction, and are not single strand.

Those three bands require the special sight 4 at one end and the special extension at the opposite end for mounting to the toy gun for the express structural combination, function, and purpose.

It is impossible to simply substitute that three-band of White for the disparate single band of Kopp, and the Board has not shown otherwise.

That "simple substitution" would be quite complex

because the recess 8 and staple 4 of Kopp are not configured to mount the disparate band of White.

In fact, the corresponding mounting elements from White would also have to be added to Kopp in order to operate the so modified toy gun.

Accordingly, the Board under its less than apparent "careful consideration" has intentionally chosen to disregard these fundamental features of the disparate references Kopp and White in, yet again, the rush to reject the claims.

This new rejection is presented at page 18 of the Decision, and it appears that the Board has chosen to add this superficial rejection because it was constrained to reverse the rejections at D.17, and now attempts to prosecute *de novo* all the claims of record to add further combinations of the references of record, with no new reference being uncovered or applied.

Note the Board is rejecting five claims in an expedient fashion without providing suitable evidence or legal motivation from KSR under a finding of similar facts.

The facts are clearly not similar, and it would appear from this new rejection that the Board has prejudged this application, and has chosen to not allow any claim, and will resort to any assertions without regard to context or legal support.

"Simple substitution" is *per se* erroneous as explained above, nor has the Board provided any similar factual basis under KSR to support that substitution when that substitution is clearly not simple.

What is simple substitution?

Clearly not simply replacing the band in Kopp with the three-bands of White, because without more, that is clearly not possible.

What is predictable result?

"Sizing the lash appropriately for the gun," the Board asserts?

Where does KSR present any similar factual basis to apply?

Of course, the three bands of White would necessarily have to be appropriately "sized" to fit the length of the stock 2 in Kopp.

But, that is not the only (i.e. "simple") change required. Much, much more modification is required as explained above, which the Board has overlooked in the rush to reject.

Furthermore, White expressly teaches that the three bands are shot away; whereas in Kopp the band is not liberated.

The whole evaluation of White and Kopp teaches again the Board's asserted simple combination.

Yet again, we have a special reference in Kopp, like Watkins, in which the special band is attached.

And, yet again the Board merely opines in hindsight that the three bands of White could be simply substituted, without regard to problem solving or any legal rationale of KSR, and the requisite legal analysis therefor.

This Board simply asserts conclusions; and such conclusions lack requisite evidentiary and legal support, and are contrary to the plain, and simple, teachings of the various references, including Kopp.

For claims 3 and 5, the Board again asserts in hindsight that since White discloses a trigger, yet again it would have been obvious to simply substitute the White trigger in Kopp for the "predictable result of providing an alternate structure enabling selective release"

"Simple substitution," the Board yet again blatantly contends without first recognizing that this same Board first made the simple substitution for the parent claims, then next made another simple substitution for these dependent claims.

We now have compounded "simple substitutions."

Is such compounding really simple under the holdings of

KSR? The Board has failed to present any evidentiary or legal basis in support thereof in yet another impermissible hindsight reconstruction.

The Board necessarily overlooks that its multiple simple substitutions have wholly modified the toy gun of Kopp from its original structure, function, and purpose into something completely different. Simply different?

The Kopp toy gun would now be unrecognizable to its inventor, in this new form fabricated by this Board in clear hindsight, and in the continued rush to reject the claims without regard to suitable legal standards.

Note, yet again, the simple and special configuration of the band 5 in Kopp and the requisite knob 6 at the end thereof.

No such configuration is disclosed or suggested in White, and the Board has not shown otherwise.

The distal end of the three bands of White lack any knob, and therefore lack any similar structure for killing insects for any predictable results in Kopp.

Predictability in Kopp requires the knob 6 to hit the insect, without which there is no evidence or teaching of effectiveness or utility.

Yet another toy the Board may opine? Clearly not.

The toy gun in Kopp requires special configuration, and the Board's proposed modifications thereof amount to a wholesale reconstruction thereof, clearly rendering inoperable that original gun for its intended purpose.

Toy purpose alone, is insufficient should the Board again so argue.

Examination of the structure, function, and purpose are required of Kopp and White, and the Board has failed in that analysis, and further compounds the errors of rejection.

Of course, the Board now has a reference relevant to striking insects, but the Board's assertions for method claim 6 fail to recognize the fundamental differences in structure

and function found in the apparatus of method claim 6.

No longer can the Board merely assert intended use and fail to afford any weight thereto.

Now, instead, the Board has Kopp for method features, but overlooks the fundamental structural and functional differences in the claim.

In Kopp, the insect must be struck by the knob 6 fired from a special toy gun.

The Board's asserted combination of White fails to recognize that that combination is much more than simple substitution, and much more than predictable results.

The three bands of White would be further modified to include the knot 6 of Kopp, since Kopp so teaches that knot 6 to strike insects.

And, the Board has failed to provide any evidence that the three bands with a knot at the end could or would be used to strike insects.

Predictable results require a similar or substituted band in Kopp with similar features for effecting the predicted results, and those features require the knob 6, lacking in White.

Perhaps the Board will again refer to Appellant's own specification for a teaching of the utility of the free loop end of his band for effective insect swatting?

That would be erroneous, but is evidence of the novel features of Appellant's claims, well lacking in the applied references.

At D.19 the Board repeats its erroneous assertion of dimensional characteristic subject to design choice and predictable results, yet again without any context to meaning or analysis, as now applied to claim 22.

The Board has failed to consider in context the likely "design choices" within Kopp and White themselves, which references are fundamentally different and have competing design objectives.

So, apply which design choice from which reference based on which combination?

In Kopp, the band is single strand with a knobbed end 6 and "is of such length that it may be stretched .. without breaking," p.1, ll. 39+.

Such length is but one feature, with strength being different, and more likely strong, like that expressly taught in Watkins.

So, Kopp would more likely require short, strong bands under the Board's application of design choice, but that choice is opposite to Appellant's claim 22, as well as related dimensional claims.

White has been addressed above, and the three bands would inherently be resilient, weak or less strong, and effect little force, in opposition to Kopp being combined therewith.

Recall the Board's own FF.13 and Hooke's Law so requires weak and little force.

So, what "design choice" does the Board really contend?

The Board's superficial assertion of design choice is yet another expedient by the Board to overlook express claim language having express structure.

The Board has previously disregarded express claim features under the assertion of mere "intended use" lacking structure, but when the claim indeed recited structure, and specific structure at that, the Board then "simply" applies the expedient of disregarding that very specific structure as mere "design choice" without recognizing the fundamental fallacy in that assertion in that the Board has previously combined disparate references having disparate features, and then bootstraps to that unwarranted precombination the further assertion of "design choice."

Remarkable, this bald assertion is; remarkable from experienced Board members.

If Appellant cannot get an objective and fair

evaluation by this Board, who then will provide that objective review? The Federal Circuit?

Appellant further traverses the new, omnibus rejection of claims 8, and 10-21 under Section 103(a) over Kopp, White, and Watkins as presented at D.19.

Notwithstanding FN.3, the Board not only does indeed consider the order of references significant, but has stacked combination of references on top of combination of references to further attack Appellant's claim in multiple shotgun manner, continued yet again at D.20 and D.21.

The fundamental irrelevance of Kopp, White, and Watkins have been presented above and apply equally here.

Neither Kopp, nor White, nor Watkins discloses "all features of" these claims as the Board simply, and yet again superficially asserts.

And, clearly no mere "simple substitution" of parts is required to convert the Kopp toy gun into any insect swatter relevant to any of Appellant's claims.

The Board's mere assertion of simple substitution of the White triple-band for the disparate band in Kopp is per se erroneous since the bands are different and their mounts are different and the functions are different.

The Board has failed to provide any evidence of predictable result of sizing when the single strand band in Kopp would be short and strong, in contradistinction to the triple bands in White which would be long and flexible with minimal force.

The Board's mere assertion of simple substitution of the latch and trigger mechanism of White for that of Kopp with no more than yield predictable result is also per se erroneous and an abuse of the KSR principles.

Note that the Board is now required to make at least two "simple substitutions," one for the disparate bands themselves without regard to the original structure and function and purpose; and secondly for the disparate latch

and trigger mechanisms, yet again without any regard to the original structure and function and purpose.

These mere assertions are expressly stacked and compounded together by the Board, and in and of themselves undermine any reasonable application of "simple substitution," instead requiring complex and multiple substitutions.

Remarkable in the Board's simple substitutions is the wholesale reconstruction of the original Kopp gun into a remarkably different toy gun, clearly destroying that original gun itself, and correspondingly rendering inoperable that original gun for its intended purpose.

The differences between Kopp and White are myriad, yet given no consideration by the Board, which has failed to consider those references in the whole, which is clear error.

KSR does not support the Board's mere assertions, and the Board has yet again fail to establish any similarity of facts between KSR and the application of the disparate references Kopp and White.

Adding to this compounding of "simple substitutions" the Board further combines yet another, third reference Watkins, for its slot to replace the pin/staple of Kopp; yet again with the bald assertion of predictable result.

Three references combined, with three different features, the Board makes with the mere assertion of "simple substitution" thrice stated. Thrice!

Abusive these assertions are.

And, written evidence by the Board itself that it has prejudged Appellant's claims and has chosen to re-reject them not "simply" but with exaggerated repetition of the various references in multiple combinations, and notwithstanding the Board's own FN.3.

The Board then compounds these blatant errors with further mere assertions that the methods of claims 8 and 13 are taught by the simple combination of Kopp and White.

As for claims 14-16 the Board admits the failure of these three references to "discuss" such features, but that is irrelevant because the Board has chosen, yet again, to disregard those very claims and the specific structural features therein under the guise or expedient of "design choice" and "predictable result."

But as well explained above, such mere Board assertion lacks evidentiary basis, lacks legal basis, and lacks technical merit, when to the contrary the various references being applied teach away from the Board's mere assertions in the sizing and configuration of the disparate bands thereof.

Appellant further traverses the additional rejection of claim 9 under Section 103(a) over Kopp, White, Watkins, and Robinson as presented at D.20.

As indicated above, the Board has failed to provide suitable evidence that these four references disclose all features of claim 9, when they clearly do not.

Note that for claim 9 the Board has expressly repeated its thrice assertion of "simple substitution," and now has added a fourth assertion of "substitution," perhaps simple no more, based on another assertion of "predictable result."

The error of this four-fold substitution assertion is self evident in the Board's need to assert four times that four disparate features would have been simple substitutions for predictable results, when, to the contrary, this is not the case, as well explained above.

It is also noteworthy that this Board has chosen to cite at D.21, the previous *In re Conte* case for the single feature of the slot, but clearly the facts are now quite different than the parent application, having different combinations and different claims.

Since the Board has chosen to apply the *res judicata* effect of the *Conte* case, then Appellant hereby requests that the Board also apply *res judicata* to each and every present claim which finds its support in the original parent

application for which the USPTO has already issued a patent therefor, and from which the claims have been derived for the special improvements therein.

The PTO through its previous three Boards of Appeal has found much subject matter allowable over the same art of record.

The PTO has not applied the parent application as prior art for the improvement application; and the improvement claims are as much entitled to the patent novelty distinction over the applied references, which were previously of record.

The Board cannot simply apply direct precedent to reject claims to the exclusion of that very same precedent which allowed the parent claims.

The present claims are equally entitled to the fundamental patentable novelty over the art of record reviewed multiple times by multiple Boards; and such claims are additionally entitled to the specific improvements recited therein, nowhere found in the parent, and nowhere found in any one of the many applied references.

Indeed, the Board has gone out of its way to repeatedly disregard the express structural features of the improved duplex lash under the misplaced guise of "design choice" when that design choice is without evidentiary, legal, or logical basis, as well explained above.

Appellant further traverses the yet again, new rejection of claim 23 under Section 103(a) over Kopp, White, and Stone as presented at D.21.

Yet again, the Board merely asserts the "simple substitution" first of disparate features from White into Kopp, and then adds further assertion of further modifying that modification of Kopp to include the selected feature from Stone for the predictable result of "creating a noise."

Remarkable, yet again is this bald assertion of simply combining multiple features to wholly reconstruct the toy gun in Kopp into an unrecognizable mutation which would clearly

be rendered inoperable for its intended purpose, and that purpose is not simply a "toy" as the Board has previously stated.

Note fundamentally, the relatively simple configuration of the Kopp toy gun, with simple single strand band having a knob 6 at one end; simple trigger 9, and simple recess 8.

Note the corresponding complexity of the disparate toy guns in White and Stone.

This Board merely asserts that one skilled in the art would find it predictable to wholly reconfigure the Kopp gun from its simple form to one that replaces the special single strand/knob with a three-band member which clearly could not or would not be suitably mounted in the Kopp gun.

And further, the Board merely asserts that the entire trigger mechanism from Kopp would have been substituted by the trigger mechanism from Stone; and for the simple reason of "creating a noise."

If the principles of KSR permit such total and absurd modifications of the Kopp toy gun, then no patent application should ever more result in an issued patent.

KSR is a significant case, and the MPEP devotes many, many sections in the objective standards thereof, conspicuously overlooked by this Board in its attempt to reject each and every claim without regard to specific evidence, without regard to objective analysis, and without regard to plain and simple logic.

To be certain, Appellant's claims recite an apparently simple structural improvement to the already patented insect swatter, but that improvement has profound and significant benefits well explained in the specification.

Appellant's insect swatter is clearly not a mere "toy" as this Board appears to believe; and any fair and objective evaluation of the applied references in the whole will provide ample evidence of the patentable novelty of the improved combination.

The Board is on record that the references fail, FAIL, to disclose the specific structural features of the improved swatter and its duplex lash.

The Board's expedient of mere "design choice" having "predictable results" has been repeatedly shown by evidence above to be without merit.

At D.17, the Board asserts "error" based on an alleged assertion by the Appellant.

However, a careful review of the main Brief and this paper will show that this Appellant is not merely making unsupported assertions.

This Appellant is required to identify and explain errors made by the examiner, and now being made by the Board, since the PTO bears the initial burden of proof in applying Section 103(a), including KSR, objectively and fairly, with due regard to express evidence, and legal rationales.

In traversing the examiner, and now this Board, this Appellant has attempted to cite in specificity the actual evidence from the disparate references being applied, not in general, and not with any distortion, as this Board has improperly done.

This Board has attempted to apply KSR in general, without identification of the different rationales A-G expressly found therein, without regard to the requirement of similar showing of facts, and without accurately identifying specific facts in the disparate references, and evaluating any facts therein in the whole and in context.

Numerous errors the Board has clearly made, as explained above.

And, quite significantly is the Board's misplaced assertions of design choice and predictable results because those provisions are readily subject to abuse as examination expedients, as this Board itself has done.

From the Board's decision, it is quite evident to this Appellant that this Board has prejudged this application

without regard to the substantial improvements over the parent patent, which patent was expressly found allowable by the PTO, and this Board is not likely to reverse itself.

Unfortunately, this Appellant is now confronted with the need to request rehearing before the same Board that first rejected the claims, *in toto*, and it would appear quite difficult for this Board to now be objective in "carefully" reviewing these many remarks.

This examiner, and previous Boards, have shown that is a quite easy or a "simple" matter for experienced examiners and more experienced members of the Board to fabricate any rejection at any time for any basis, *ad infinitum*, as this same Appellant has previously predicted.

Should this Board sustain its many rejections, then this Appellant makes the respectful plea to the Board to at least attempt to address specific errors identified by the Appellant, and specify both the factual and legal bases under KSR in support of the Board's decision.

Since the Board has relied substantially on "design choice" assertions, this Appellant further requests that the Board cite relevant case law, either to specific pages in KSR, or other case law in support of the design choice assertions.

This Appellant further requests that the Board also cite its case law for non-analogous art as relevant to Appellant's claims, and how the Board applies or distinguishes the preamble case law, including Kropa.

Perhaps, this Board would also make the constructive suggestion of what the Board in its experience would require in Appellant's preambles that would comply with Kropa to bring life and meaning to the claims for further distinguishing Appellant's insect swatter, as a machine or apparatus, over the mere toy guns being applied?

And furthermore, since Appellant asserts the inoperability of the various combinations of the disparate

references being applied, Appellant also requests that the Board cite relevant case law in support of its simple holding that the "toys" in and of themselves are sufficiently operable as toys without regard to the structure, function, and express purpose thereof.

Appellant is before this Board in good faith, and in good faith this Appellant can only request of this Board express and specific factual and legal bases to support the various rejections.

It would be in the interest of both this Appellant and the PTO that the issues being carefully reviewed to present a specific and complete record should further appeal to the Federal Circuit be next required.

The Board well recognizes the exceptionally protracted prosecution of both the parent application and this improvement application, and this Appellant has always expected cooperation from both the examiner and the multiple Boards to reduce or overcome issues in allowing suitable claims for the basic insect swatter, and now the substantial improvements therein.

The PTO, and the Board, have limited resources, and Appellant's preference is to cooperate with the PTO in resolving allowable claims; and this Appellant would rather not have to further appeal this application, as was required in the parent application.

This Board should further recall that the previous Board fully reversed the examiner, and two Boards before that previously reversed the same examiner.

There can be no doubt of allowable subject matter in the parent application, since, of course, the PTO granted a patent therefor.

And, there can be no doubt that allowable subject matter is present in the present improvement claims, for example for those many features clearly not disclosed or suggested in the many references applied, but afforded no

weight by the Board under the assertion of mere "design choice."

Careful reconsideration of the applicable case law on design choice is warranted by this Board, which reconsideration should result in the withdrawal of corresponding rejections of those claims.

There are many claims of record, varying in specificity, and surely, this Board can use its great experience in finding some allowable subject matter which is consistent with the substantial improvement due to the duplex lash being recited.

The Board should be ever mindful that where all the applied references teach various toy guns, they all appear to share the common objective of maximum range and maximum force, as evident in the Board's use of design choice and predictable result.

In stark contrast, the duplex lash insect swatter recited in Appellant's claims is not configured in that manner, but in an opposite manner, for instead of maximizing shooting force, the duplex lash becomes more resilient with correspondingly less force when operated for increasing striking range and accuracy, and avoiding the need and expense of custom bands for that operation.

In Watkins, Kopp, and Stone the different bands share the common objective of shooting projectiles with maximum range and force, which is effected by short and strong bands, found undesirable for Appellant's insect swatter.

And in White and Stone, the disparate bands thereof are themselves shot away, and those bands would therefore be similarly configured under the Board's design choice assertion for maximum range and, perhaps, force, which would again require short and strong bands to meet that result, or predictable result.

In stark contrast, the duplex lash in the recited insect swatter is specifically configured to enhanced

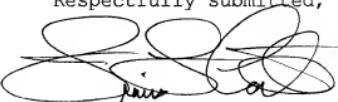
resiliency in which force is reduced, but whipping action is created whose range is significant in the efficacy of the insect swatter, as opposed to the mere toy guns of the applied references.

Perhaps, now, this Board can carefully and objectively reevaluate its original decision and find reason to withdraw some or all of those rejections?

Perhaps?

Accordingly, Appellant hereby requests reconsideration of the original decision, and further requests that the various rejections be withdrawn as being unsupported by due evidence and suitable legal support under Section 103(a) and KSR.

Respectfully submitted,



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Date: 28 April 2009

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